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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,197	04/20/2001	David W. Cannell	05725.0505-00	1548

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EXAMINER	
ELHILO, EISA B	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application N .	Applicant(s)	
	09/838,197	CANNELL ET AL.	
	Examin r	Art Unit	
	Eisa B Elhilo	1751	

--The MAILING DATE of this communicati n appears on th cover sheet with the correspondence address --

THE REPLY FILED 17 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *17 December 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: *None*.

Claim(s) objected to: *None*.

Claim(s) rejected: *1-74,157 and 158*.

Claim(s) withdrawn from consideration: *75-156,159 and 160*.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: Applicant has not presented any additional data or showing to overcome the rejection of record. The arguments presented and dated on 12/17/2004, merely rehash the arguments presented earlier, which fully responded by the examiner in previous office action mailed July 22, 2004. Further, with respect to the argument that the Kolc et al. does not expressly or inherently teach the composition has a pH value effective to lanthionize the keratin fibers.

The examiner's position is that Kolc et al., teaches a composition comprising mercaptan derivatives such as 2-amino-3-mercaptopropic acid, from about 2.0% to about 3.0% of cysteine compound (see col. 4, lines 31-49), amines such as alkanolamine and ammonia, metal hydroxides (see col. 5, lines 65-68) and alcohols such as ethanol and isopropanol (see col. 7, lines 32-33) and other constituents such as fatty alcohols (see col. 6, lines 2-3) and ammonium carbonate (see col. 5, lines 65-66) and wherein the composition has a pH in the range of about 7.5 to about 9.5 (see abstract), and, thus, the composition has the same ingredients that recited in the instant claims and therefore, they should have identical chemical properties include the lanthionization property Further, the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto,* 136 USPQ 458, 459 (CCPA 1963).

With respect to the argument that neither Kolc nor Mougin alone or in combination teaches or suggests a pretreatment composition for lanthionizing keratin fibers as recited in claim 36.

The examiner's position is that the recitation "pretreatment composition for lanthionizingof keratin fibers" has not been given patentable weight because the recitation occurs in the preamble. Apreamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completenss but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Margaret Einsmann

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GROUP 1100